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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,503	08/31/2009	7016481	007458.0001	6222

7590 02/11/2015
NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON
SUITE 4600
CHICAGO, IL 60602

EXAMINER

CRAVER, CHARLES R

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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02/11/2015

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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95/001,165	04/01/2009	7016481	29776.178	5241

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC., SKYPE TECHNOLOGIES SA
and RTX TELECOM A/S
Requesters, Respondents and Cross-Appellants

v.

RIPARIUS VENTURES, LLC
Patent Owner, Appellant and Cross-Respondent

Appeal 2013-006969
Reexamination Control 95/000,503 and 95/001,165 (merged)
Patent 7,016,481 B2
Technology Center 3900

Before JOHN A. JEFFERY, KEVIN F. TURNER, and
STANLEY M. WEINBERG, *Administrative Patent Judges*.

WEINBERG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Patent Owner Riparius Ventures, LLC (“Riparius”) requests rehearing (Req. Reh’g) under 37 C.F.R. § 41.79 in the above-entitled *inter partes* reexamination of US 7,016,481 B2 (“the ‘481 Patent) with respect to the conclusion of the Patent Trial and Appeal Board (“Board”) that the Examiner did not err in rejecting claims 1-28. Decision on Appeal mailed on March 3, 2014. (“Dec.”). Requester Cisco

Systems, Inc. (“Cisco”) opposes the Request for Rehearing in Comments filed on May 2, 2014 (“Cisco Comments”). Requesters Skype Technologies SA and RTX Telecom A/S (“Skype”) also oppose the Request for Rehearing in Comments filed on May 5, 2014 (“Skype Comments”).

37 C.F.R. § 41.79(b) states in part that “[t]he request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board’s opinion reflecting the decision. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing” with certain exceptions not applicable here.

We deny rehearing.

CLAIM 7

Riparius contends that our Decision overlooked “the point that, even if claim 1 was properly rejected because it did not exclude standard telephones, [dependent] claim 7 does exclude standard telephones.” Req. Reh’g 1-2.

Claim 7 recites: “A device as in claim 1 wherein said remote cordless base unit comprises circuits separated into isolated millivolt level audio transmit and receive.”

Riparius’s contention that its Specification disavows a standard telephone

Our Decision recognized Riparius’s contention, relying upon *In re Abbott Diabetes Care Inc.*, 696 F.3d 1142 (Fed. Cir. 2012) (“*Abbott Diabetes*”), that the ‘481 Patent’s creation of a unique device constitutes a disavowal of the use of a standard telephone. Dec. 29. We concluded, nevertheless, that “the ‘481 Patent’s Specification does not disavow a standard telephone.” Dec. 30. We based our

conclusion in part upon the following statements in the ‘481 Patent: “In one embodiment the Base 105 and Handset 107 communicate using *standard* 900 mhz radios.” Col. 3, ll. 4-6 (emphasis added). “In other embodiments of the invention. . . a *standard* Cordless Telephone Circuit 720 was modified only to the extent of adding a balanced Hybrid Circuit 710 to separate transmit and receive audio from the POTS Tip and Ring 715.” Col. 6, ll. 16-21 (emphasis added). At the Oral Hearing, Riparius acknowledged that this discussion described an embodiment of the invention: “Would I go back and maybe ask the patent prosecutor why he put in other embodiments of the invention at column 6 beginning at line 20?¹ Sure, I would say that shouldn’t be in there and that’s a good point that the requesters made.” Oral Hearing Transcript (“Tr.”) 49:8-11. Riparius now asks us to reconsider our conclusion that the ‘481 Patent does not disavow a standard telephone: “Respectfully, the specification does disavow a standard telephone. The specification could not be more clearer that standard telephones, and standard telephone adapters, are verboten.” Req. Reh’g 4.

Riparius bases its rehearing request on parts of its Specification that refer to a specialized device, a unique device, circuitry that differs significantly from a standard telephone, and how its device overcomes prior art deficiencies. Req. Reh’g 2-4. More specifically, Riparius refers to statements in columns 1, 2, 6, and 7 of the Specification. Even more specifically, Riparius’s citations to column 6 refer to lines 48-58 and 66-67. Req. Reh’g 3-4. Riparius does not refer either to the column 3 or column 6 citations we identified in the Decision and does not

¹ Actually, Riparius’s citation to column 6, line 20 was a citation to the identical text in its US Patent No. 7,139,371 which our Decision identified as a related patent argued at the same time as the ‘481 Patent.

explain why our reliance upon those citations was erroneous. Riparius also does not contend that our interpretation of *Abbott Diabetes* was incorrect or that our application of *Abbott Diabetes* to the facts of this case was incorrect.

Accordingly, Riparius has not persuaded us that we misapprehended or overlooked parts of its Specification in our discussion of whether its Specification disavows a standard telephone.

Riparius also contends that “Claim 7 adds the limitation the Decision found lacking in claim 1 (Req. Reh’g 1), that “claim 7 does exclude standard telephones” (Req. Reh’g 2) and that

Claim 7 adds exactly what the specification describes at column 6, lines 48-58, that is, isolated transmit and receive circuits that make the invention different from a standard telephone. Even if the rejection of claim 1 is correct -- which Riparius does not concede -- the rejection of claim 7 is an error.

Req.Reh’g 5.

Our Decision concluded that, for the rejection of claim 7 as obvious over Peterson, Foo, and Papadopoulos, the Examiner relied upon the reasons set forth in Skype’s Request 41-43, thereby finding that Papadopoulos, not Peterson, teaches millivolt transmit and receive. Dec. 33. We were not persuaded that the Examiner erred because Riparius contended that *Peterson* does not disclose a specialized circuit having the isolated circuits. *Id.*, citing App. Br. 21. We are further not persuaded of Examiner error because the Examiner also found that Papadopoulos teaches using millivolts on the isolated receive circuitry. *See* Skype Request 43.

The Examiner rejected claim 7 on multiple bases, which Riparius individually and specifically addressed: obvious over Ereksen in view of Papadopoulos (App. Br. 4, rejection 1; App. Br. 12-13); Prentice in view of

McKinnon and Papadopoulos (App. Br. 4, rejection 6; App. Br. 17-18); Jones in view of Norstar (App. Br. 4, rejection 7; App. Br. 18); Peterson in view of Foo and Papadopoulos (App. Br. 5, rejection 10; App. Br. 21); and Peterson in view of Frantz and Papadopoulos (App. Br. 5, rejection 15; App. Br. 24).

In its Request for Rehearing, instead of contending that we misapprehended or overlooked its arguments regarding Papadopoulos for the Peterson/Foo/Papadopoulos (Rejection 10) combination which our Decision relied upon, Riparius reproduces arguments it made regarding Papadopoulos in opposition to a different combination - the Ereksen/Papadopoulos (Rejection 1) combination. *See* Req. Reh’g 5-6, citing App. Br. 12-13. Riparius’s Request for Rehearing does not contend that its Appeal Brief regarding the Rejection 10 combination incorporated by reference its arguments regarding the Rejection 1 combination. But, we will assume that its Appeal Brief did intend to indicate an incorporation by reference by stating, “Papadopoulos uses a standard handset. (VII.D.1)².” App. Br. 21.

For Rejection 1, Riparius contended that “Papadopoulos does not have isolated, separate, send and receive circuits **in the base**, as required by claim 7.” Req. Reh’g 5, quoting Appeal Br. 13. This argument is not persuasive because it argues limitations that are not recited in claim 7. *Compare* claim 7: “said remote cordless base unit comprises circuits separated into isolated millivolt level audio transmit and receive” *with* Riparius’s restatement of claim 7: “isolated, separate, send and receive circuits in the base.” *See also* Req. Reh’g 9 (“the circuitry in the base unit, which is the subject of claim 7”).

² We will further assume Riparius meant to cite VIII.D.1.

The Request for Rehearing refers to, and quotes with partial emphasis, paragraph 39 of the First McElvaney Rule 132 Declaration, which was referenced, but not reproduced, on page 12 of its Appeal Brief regarding Rejection 1. *See* Req. Reh’g 6-7. Riparius’s emphasized portions of paragraph 39 are not persuasive because they rely upon versions of claim 7 that are not actually recited in the claim. *See* paragraph 39’s restatement of claim 7: “the patent claims at issue cover a 4 wire base operating at millivolt levels;” the Papadopoulos reference does not refer to “the circuitry in a cordless phone base;” Papadopoulos “cannot ‘isolate send and receive from each other’ as claimed.” Req. Reh’g 7.

We also do not consider Riparius’s reliance upon column 2, lines 47-51 of Papadopoulos (Req. Reh’g 6) because not even its argument regarding the Rejection 1 combination relied upon this column 2 citation. We therefore could not have misapprehended or overlooked it.

For the above reasons, we deny rehearing regarding claim 7.

Alternatively, Riparius asks us to return the case to the Examiner “so that amendments to the claims may be proposed.” Req. Reh’g 10. Because Riparius does not explain why it did not avail itself of the opportunity to amend claim 7 during reexamination, we decline to order a remand.

CLAIM 1

Our Decision affirmed the rejection of claim 1 based upon the Peterson/Foo (Rejection 9) combination. *See* Dec. 7, 25-31.

Riparius contends that our Decision incorrectly concluded that “Riparius did not identify elements in claim 1 that would cause claim 1 to exclude a standard telephone” and that “[t]he Decision [did] not consider Riparius’s response to this question. Req. Reh’g 7-8, citing Decision 31. Specifically, page 31 of our

Decision concluded that “Riparius has not identified elements that are recited in the claim to make it unique and which cannot be imported into the claim from the Specification.” Regardless, we did consider Riparius’s argument at the hearing that “when the claim is read ‘as a whole,’ it ‘cannot be construed to read upon a standard two wire telephone.’” Dec. 29, citing Tr. 14:1-3.

Riparius also contends we did not consider its counsel’s argument reproduced at pages 48-49 of the transcript, referring to a base having two kinds of circuitry recited in claim 1: circuitry for translating communications and circuitry for receiving digital data and translating the digital data. *See* Req. Reh’g 8-9. Relying upon the cited transcript, Riparius contends that “[t]here are limitations in the preamble and in the body of claim 1 that show the use of a specialized device with two circuits, one for transmission and one for reception.” Req. Reh’g 9.

Also according to Riparius, the cited transcript shows it “argued that the ‘device’ in the preamble excluded a standard phone.” Req. Reh’g 8. We do not see, however, where the cited transcript refers to the preamble.

37 C.F.R. § 41.73(e)(1) states: “At the oral hearing, each appellant . . . may only . . . present argument that has been relied upon in the briefs” with an exception that does not apply here.

Neither Riparius’s oral argument nor its Request for Rehearing informs us where its briefs contended that the base having the two identified circuitry limitations showed the use of a specialized device with two circuits and/or excluded a standard phone. We have not found any such arguments in Riparius’s briefs.

Even if we were to consider this argument now, we conclude that Riparius’s briefs did not contest the Examiner’s finding (RAN 28), adopted from Skype’s

proposed rejection over Peterson and Foo, that the combined two references teach both base unit “circuitry” limitations. *See* Skype Request 30-31. Riparius has not pointed us to anything in their briefs showing that it did contest these Examiner findings.

Furthermore, as noted in the transcript reproduced on page 8 of the Request for Rehearing, Riparius’s counsel effectively acknowledged that Riparius had not presented an argument with particularity regarding the “circuitry” limitations: “The third reason I think it’s in the claim and this is something we should have flagged for you better than we did . . . I don’t even think this was gone into any real detail on the reexaminations.”

Accordingly, we conclude that we did not misapprehend or overlook arguments regarding the base unit “circuitry” limitations in the base unit and we deny rehearing on that basis.

Discussing our reference to standard telephones in columns 3 and 6 of the ‘481 Patent, Riparius contends that our Decision “[did] not consider column 6 as a whole.” Req. Reh’g 9. Although at the hearing, Riparius asked us to consider claim 1 as a whole (Tr. 14:1-3), we have not found where Riparius asked us to consider column 6 as a whole. More specifically, Riparius contends we focused on column 6, lines 16-21 of the ‘481 Patent to the exclusion of other parts of column 6 which identify various problems with the embodiment described in lines 16-21.

Riparius does not dispute, however, that the ‘481 Patent does, in fact, describe an embodiment of its invention using standard equipment. Rather, at the hearing, Riparius acknowledged that the discussion beginning at column 6, line 16³

³ *See* footnote 1.

of the '481 Patent described an embodiment of the invention: "Would I go back and maybe ask the patent prosecutor why he put in other embodiments of the invention at column 6 beginning at line 20? Sure, I would say that shouldn't be in there and that's a good point that the requesters made." Tr. 49:8-11.

Finally, Riparius asks us to return this case to the Examiner so that Riparius can amend the claims. Req. Reh'g 10. Because Riparius does not explain why it did not avail itself of the opportunity to amend the claims during reexamination, we decline to order a remand.

DECISION

We have granted Riparius's request for rehearing to the extent that we have reconsidered our Decision affirming the Examiner's decision unfavorable to the claims; but we decline to modify our Decision in any way.

Pursuant to 37 C.F.R. § 41.79(d), this decision is final for the purpose of judicial review. A party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

REHEARING DENIED

Appeal 2013-006969
Reexamination Control 95/000,503 and 95/001,165 (merged)
Patent 7,016,481 B2

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